

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH R. GREULICH and THOMAS M. BROAD

Appeal No. 96-3093
Application 08/046,880¹

ON BRIEF

Before HAIRSTON, BARRETT and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 23 through 29 and 41 through 49, all the other claims having been

¹ Application for patent filed April 14, 1993. According to appellants, the application is a division of Application 07/569,128, now U.S. Patent No. 5,241,464, issued August 31, 1993.

canceled².

The disclosed invention relates to the computer selection and display means having means for controlling the computer and the monitor. The control means provides a first set of a plurality of selectable options on the monitor, a second and a third set of plurality of selectable options overlying, but not completely obscuring, the first set of options. The control means also provides a fourth set of selectable options graphically displayed with the second and the third set of options and highlighting only selected ones of the fourth set of options depending upon the selections made out of the second and the third sets of options. The control means further comprise means responsive to preliminary selection of the fourth set of options for pictorially illustrating a simulation of an object, such as a business form, to be created by the invention, so that an operator may more easily visualize the object to be created.

² Two amendments after the final rejection were filed, and were entered in the record.

Representative claim 23 is reproduced as follows:

23. Computer selection and display means comprising:

a computer having a monitor; and

means for controlling said computer and said monitor: to provide a first set of a plurality of selectable options on said monitor; to provide a graphic display of second and third sets of selectable options overlying, but not completely obscuring, the first set of options; and for providing a fourth set of selectable options graphically displayed with said second and third sets of options, and highlighting only selected ones of said fourth set of options depending upon the selections of said second and third sets of options.

The references relied on by the examiner are:

Day, Jr. et al.(Day)	4,763,356	Aug. 9, 1988
Crandall et al.(Crandall)	5,165,012	Nov. 17, 1992

Claims 23 through 29 and 41 through 49 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Day and Crandall [Answer, page 2].

Reference is made to Appellants' briefs³ and the Examiner's answer for their respective positions.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 23

³ A reply brief was filed on December 7, 1995 and entered in record.

through 29 and 41 through 49.

With respect to independent claim 23, the Examiner contends that Day's examples in figures 3 to 10 suggest that several selectable options can be displayed on top of the set of selectable options as claimed. The Examiner also asserts that Crandall, for example in figure 18, teaches that several sets of selectable options can be displayed on top of the first set of selectable options in a system such as Day's. The Examiner concludes that it would have been obvious, to one of ordinary skill in the art at the time of the invention, to configure, in view of the teaching of Crandall, Day's system as claimed. [Answer, pages 2 to 3].

Appellants argue that the suggested combination of Day and Crandall would only produce the following result. If the touch screen of Day were a calendar or the like in Crandall, the user would touch a date, which would then be highlighted for the user to put in certain notes. Appellants further argue that one having skill in the art would not conclude from these teachings that multiple screens overlying one another would be created. [Brief, pages 7 to 8]. Appellants also

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argue that the applied prior art, individually or in combination, does not teach the feature of highlighting only selected ones of the fourth set of options depending on the selections made from the second and the third sets of options. [Brief, pages 4 to 6].

The Examiner responds that, in Crandall, the equivalent "second and third sets of options" are the touchable boxes (column 7, lines 30 to 34) of the calendar 502 wherein the invisible/indistinctable (e.g., black background) icon is activated only when at least one of these boxes is selected. [Answer, page 4]. The Examiner also contends that "Crandall teaches a calendar display system in which when a certain specific icon (e.g., date box 504) has been selected, . . . features in the selected icon are highlighted (column 7, lines 39 to 43)" [Answer, page 4].

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S.

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1, 17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

As indicated by the cases just cited, an examiner has at least two responsibilities in setting forth a rejection under 35 U.S.C. § 103. First, the examiner must identify all the differences between the claimed invention and the teachings of

the prior art. Second, the examiner must explain why the identified differences would have been the result of an obvious modification of the prior art.

In our view, here the Examiner has properly addressed his first responsibility, but has not met his second responsibility. That is, the Examiner has not established a prima facie case of obviousness.

We agree with Appellants that the Examiner's suggested combination does not meet the limitations of claim 23. Specifically, the combination does not teach a second and a third set of a plurality of selectable options overlying, but not completely obscuring, the display showing the first set of selectable options. Day does disclose a display showing a first set of selectable options and a second screen overlying, but not completely obscuring, the first display, and having a second set of selectable options, see for example figure 3. But Day does not teach a third screen similar to the second screen, a claimed feature [Claim 23, lines 4 to 5]. Crandall, too, does not teach this feature. The Examiner has directed our attention to figures 5 and 18, and column 7, lines 30 to

34, and lines 39 to 43 of Crandall. These references to Crandall do not teach this limitation. The same is true of the limitation of "providing a fourth set of selectable options graphically displayed with said second and third set of options," [Claim 23, lines 6 to 7]. We further find that the suggested combination further fails to meet the limitation of "highlighting only selected ones of said fourth set of options depending upon the selections of said second and third options" [Claim 23, lines 7 to 9]. Again, the cited text and the figures of Crandall which the Examiner argues for this limitation do not meet this limitation.

Thus the collective teachings of Day and Crandall do not support the rejection proposed by the Examiner. We conclude that the evidence of obviousness produced by the Examiner fails to support the rejection of independent claim 23. Since claims 24 through 29 and 41 through 49 all depend on claim 23, the rejection of these claims on the same ground likewise falls.

DECISION

The decision of the Examiner rejecting claims 23 through 29 and 41 through 49 under 35 U.S.C. § 103 over Day and

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Crandall is reversed.

REVERSED

	KENNETH W. HAIRSTON)	
	Administrative Patent Judge)	
)	
)	
	LEE E. BARRETT)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	PARSHOTAM S. LALL)	
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